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Paper No. 9

In re Application of: Yoram Nelken )  
Application No. 10/008,152 )  
Filed: December 4, 2001 )  
For: SYSTEM AND METHOD FOR )  
AUTOMATIC TASK )  
PRIORITIZATION )

**DECISION ON PETITION  
FOR ACCELERATED  
EXAMINATION UNDER  
M.P.E.P. §708.02(VIII)**

This is a decision on the request for reconsideration filed December 9, 2001 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special. The petition was filed in response to a dismissal of the original petition filed August 21, 2002.

The Petition is **DENIED**.

**BASIS OF DECISION**

The following are the relevant portions of the MPEP and Regulations:

**M.P.E.P. §708.02, Section VIII**

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

...

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.

**37 C.F.R. §1.111 Reply by applicant or patent owner to a non-final Office action.**

(b) .... The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. ... A general allegation that the claims define a patentable invention *without specifically pointing out how the language of the claims* patentably distinguishes them from the references does not comply with the requirements of this section. *[Emphasis added]*

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner **must clearly point out the patentable novelty** which he or she thinks **the claims present** in view of the state of the art disclosed by the references cited or the objections made. **[Emphasis added]**

### DECISION

The decision mailed October 3, 2002 dismissed the petition based upon a failure to provide a detailed discussion of the references, which points out with particularity how the claimed subject matter is patentable over the references to the extent required by 37 CFR 1.111(b) and (c).

Applicant makes no effort to correct the noted deficiency. Instead applicant submits that the original petition was adequate in that it "discusses each reference in sufficient detail to distinguish it from Applicant's claimed invention".

In this instance, Applicant's submission describes each reference succinctly and then attempts to differentiate with compound statements which depend on language not found in the independent claims. For example, "Using the results of natural language processing to assign a priority to a communication, as claimed by Applicant, is not disclosed or taught by this patent" is given as the reason for patentability over the first 9 references. The claims make no mention of "natural language processing". Therefore, this discussion fails to point out with particularity how the **claimed** subject matter is patentable over the references.

Accordingly, the Petition is **DENIED**.

The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

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